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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,358	03/14/2005	David Teh-Wei Chou	033495-014	9951
21839 7590 07/30/2008 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404				
EXAMINER SZNAIDMAN, MARCOS L				
ART UNIT 1611		PAPER NUMBER		
NOTIFICATION DATE 07/30/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary

Application No.

10/506,358

Applicant(s)

CHOU ET AL.

Examiner

MARCOS SZNAIDMAN

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 1-3, 7, 8 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 4 pages 03/02/04
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to applicant's reply filed on March 20, 2008.

Election/Restrictions

Applicant's election with traverse of Group II in the reply filed on March 20, 2008 is acknowledged. The traversal is on the ground(s) that the criteria for a proper restriction the inventions must be independent or distinct, and second there has to be an undue burden on the Examiner. This is not found persuasive because the criteria for "unity of invention" for US national stage applications filed under 35 U.S.C. 371 is different than the criteria for "restriction" for non-provisionals filed under 35 U.S.C. 111 (a). The criteria for "unity of invention" is regulated by PCT Rule 13 (see MPEP 1850) which requires a "special technical feature".

The requirement is still deemed proper and is therefore made FINAL.

Applicant's election of compound 2-12 (Table II) as the elected species in the reply filed on March 20, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Since the elected species is free of prior art, examination was expanded to the following species: 3-cyano-1-(2,6-dichloro-4-trifluoromethylphenyl)-5-hydroxymethylamino-4-trifluoromethylsulphinylpyrazole (CAS# 380220-19-9).

Status of Claims

Claims 1-10 are currently pending and are the subject of this office action.

Claim 1-3, 7-8, and 10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on March 20, 2008.

Claims 4-6 and 9 are presently under examination.

Priority

The present application is a 371 of PCT/EP03/02009 filed on 03/05/2002, and claims priority to provisional application No. 60/361328 filed on 03/05/2002 and EPO 02027033.6 filed on 12/03/2002.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 4 and 5 are rejected under 35 U.S.C. 102(a) as being anticipated by Rousseau (WO 2001/94315).

Claims 4 and 5 recite a 5-substituted-alkylaminopyrazole derivative of formula I as in claim 1, or pesticidally acceptable salts thereof.

For claim 4 and 5, Rousseau teaches the compound: 3-cyano-1-(2,6-dichloro-4-trifluoromethylphenyl)-5-hydroxymethylamino-4-trifluoromethylsulfinylpyrazole (CAS# 380220-19-9, see page 4, structure V and lines 25-26), wherein R1 is CN, R2 is Cl, R3 is CF3, W is C-Cl, R4 is H, R5 is H, R6 is CF3, A is C1-alkylene, and n is 1, which anticipates the compounds of general formula I of claims 4 and 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rousseau (WO 2001/94315).

Claim 6 recites a 5-substituted-alkylaminopyrazole derivative of formula I, or pesticidally acceptable salts thereof, wherein: R1 is CN; R2 is Chlorine; R3 is CF3 or OCF3; W is C-Cl; R4 is Hydrogen or (C1-C6)-alkyl; R5 is (C1-C6)-alkyl; R6 is CF3; A is (C2-C3)-alkylene and n is zero, one or two.

For claim 6, Rousseau does not teach a compound with the above limitations, however, Rousseau teaches the compound: 3-cyano-1-(2,6-dichloro-4-trifluoromethylphenyl)-5-hydroxymethylamino-4-trifluoromethylsulphinylpyrazole (CAS# 380220-19-9, see page 4, structure V and lines 25-26), wherein R1 is CN, R2 is Chlorine, R3 is CF3, W is C-Cl, R4 is Hydrogen, R5 is H, R6 is CF3; A is C1-alkylene

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and n is 1. This compound differs from the general compounds encompassed by instant claim 5 in that R5 is Hydrogen instead of C1-alkyl (i.e. methyl) and A is C1-alkylene instead of C2-alkylene. In other words, the compound of the prior art has one less methylene group in A, and one less methylene group in R5. MPEP 2144.09 section II, says that homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by $-CH_2-$ groups) are generally of sufficient close structural similarity that there is presumed expectation that such compounds possess similar properties. MPEP 2144, Section III states: prior art structures do not have to be true homologs or isomers to render structurally similar compounds *prima facie* obvious. *In re Payne*, 606 F.2d 303, 203 USPQ 245 (CCPA 1979) (Claimed and prior art compounds were both directed to heterocyclic carbamoyloximino compounds having pesticidal activity).

The only structural difference between the claimed and prior art is that the ring structures of the claimed compounds had two carbon atoms between two sulfur atoms, whereas the prior art ring structures had either one or three carbon atoms between two sulfur atoms. The court held that although the prior art compounds were not true homologs or isomers of the claimed compounds, the similarity between the chemical structures and properties is sufficiently close that one of ordinary skill in the art would have been motivated to make the claimed compounds in searching for new pesticides). *In re Gyurik*, 201 USPQ 552, 596 F.2d 1012 on page 557 states: "In obviousness rejections based on close similarity in chemical structure, the necessary motivation to make a claimed compound, and thus the *prima facie* case of obviousness, rises from

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the expectation that compounds similar in structure will have similar properties.” In this case, is expected that the compounds of the prior art ant the instant application, differing only in one methyl group and one methylene group would have similar chemical, physical and biochemical properties.

At the time of the invention, it would have been *prima facie* obvious for a person of ordinary skill in the art to replace an Hydrogen group of the compound described in the prior art with a methyl group and a C1-alkyl with a C2-alkyl, with the motivation of obtaining compounds with similar chemical, physical and biological properties, thus resulting in the practice of claim 6, with a reasonable expectation of success.

Claims 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rousseau (WO 2001/94315) as applied to claim 6 above, further in view of Akers (Journal of Pharmaceutical Sciences (2002) 91:2283-2300)

Claim 9, further limits claims 4-6, wherein the compound of formula I is part of a composition comprising a pesticidally acceptable diluent or carrier and/or surface active agent.

Rousseau teaches all the limitations of claim 9 except for the pesticidally acceptable diluent or carrier and/or surface active agent. However Akers teaches that excipients (e.g. diluents, carriers, surface active agents) are well known in the art (see abstract and introduction).

At the time of the invention, it would have been *prima facie* obvious for a person of ordinary skill in the art to select an acceptable excipient to formulate 3-cyano-1-(2,6-

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dichloro-4-trifluoromethylphenyl)-5-hydroxymethylamino-4-

trifluoromethylsulphinyldiazole, since according to Akers these are common practices in the pesticide and agrochemical industries, thus resulting in the practice of claim 9 with a reasonable expectation of success.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCOS SZNAIDMAN whose telephone number is (571)270-3498. The examiner can normally be reached on Monday through Thursday 8 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila G. Landau can be reached on 571 272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARCOS SZNAIDMAN/
Examiner, Art Unit 1611
July 23, 2008

/Sharmila Gollamudi Landau/

Supervisory Patent Examiner, Art Unit 1611